

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 99-372-F)

PATENT

In re Application of: Welcher et al.)	
)	
Serial No.: 09/927,850)	Before the Examiner: J. Seharaseyon
)	
Filed: August 10, 2001)	Group Art Unit: 1647
)	
For: Interferon-Like Molecules)	Confirmation No.: 6938
and Uses Thereof)	

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

DECLARATION OF DONALD L. ZUHN, JR.

I, Donald L. Zuhn, Jr., hereby declare:

1. I have assisted Dr. Kevin E. Noonan with the prosecution of U.S. Application No. 09/927,850 ("the '850 application"), as well as with the prosecution of related U.S. Application Nos. 09/724,860 ("the '860 application") and 11/200,389 ("the '389 application").

2. On January 6, 2005, I filed a Notice of Appeal (Exhibit A), appealing the final rejection of claims 1-20 in the '850 application. At the time I filed the Notice of Appeal, I also filed a Petition for a Three-Month Extension of Time and a Transmittal Letter containing a general authorization to charge or credit fees (Exhibit A).

3. On August 8, 2005, I withdrew the above Notice of Appeal by filing a continuation application – U.S. Application No. 11/200,389 (the '389 application) – claiming the benefit of the '850 application. At the time the '389 application was filed, I included a Utility Patent Application Transmittal (Exhibit B) stating that the '389 application "is a CONTINUING APPLICATION," and in particular, that the '389 application "is a Continuation of prior U.S. Patent Application Serial No.[] 09/927,850 filed August 10, 2001."

4. The twenty claims that were presented at the time the '389 application was filed (Exhibit C) were identical to the twenty claims that were presented on June 10, 2004 during prosecution of the '850 application (Exhibit D). In addition, at the time the '389 application was

filed, I filed a copy of the Declaration and Power of Attorney for Patent Application that was originally filed with U.S. Application No. 09/724,860 (the '860 application'¹) (Exhibit E). Thus, I intended to file the '389 application as a continuation of the '850 application.

5. For the '389 application to secure the benefit of '850 application, a five-month extension of time should have been filed in the '850 application on August 8, 2005, the date on which the '389 application was filed. The omission of the request for extension of time in the '850 application was inadvertent and not intentional, since copendency between the '850 application and the '389 application would have been required for the '389 application to properly claim the benefit of the '850 application as a continuation of that application.

6. In September 2005, I received and reviewed a Filing Receipt (Exhibit F) for the '389 application. The Filing Receipt, which was mailed September 15, 2005, indicates that the '389 application "is a CON of 09/927,850 8/10/2001" (Exhibit F). After receiving the Filing Receipt, I reviewed it to ensure that the information on it was accurate, and on October 10, 2005, I sent a reporting letter to the Assignee of the '389 application, noting that the Filing Receipt had been reviewed and the information on it (including the priority claim to the '850 application) had been found to be accurate. At the time the Filing Receipt was received, the Office provided no indication that the '850 application had gone abandoned on March 7, 2005 (and therefore, that the '389 application was not properly entitled to the benefit of the '850 application), and I had no reason to believe that the '850 application had gone abandoned on March 7, 2005.

7. In November 2005, I received and reviewed an Updated Filing Receipt (Exhibit G) for the '389 application. The Updated Filing Receipt, which was mailed October 24, 2005, indicates that the '389 application "is a CON of 09/927,850 8/10/2001" (Exhibit G). After receiving the Updated Filing Receipt, I reviewed it to ensure that the information on it was accurate, and on November 7, 2005, I sent a reporting letter to the Assignee of the '389 application, noting that the Updating Filing Receipt had been reviewed and the information on it (including the priority claim to the '850 application) had been found to be accurate. At the time the Updating Filing Receipt was received, the Office provided no indication that the '850 application had gone abandoned on March 7, 2005 (and therefore, that the '389 application was not properly entitled to the benefit of the '850

¹ The '850 application is a divisional application of the '860 application.

application), and I had no reason to believe that the '850 application had gone abandoned on March 7, 2005.

8. In November 2005, I received and reviewed a Notice of Abandonment (Exhibit H) for the '850 application. The Notice states that '850 application was "abandoned in view of . . . Applicant's failure to file to timely file a proper reply to the Office letter mailed on 06 January 2005" (Exhibit H). At the time the Notice of Abandonment was received, the Office provided no indication that the '850 application had gone abandoned on March 7, 2005, and I had no reason to believe that the '850 application had gone abandoned on March 7, 2005.

9. In November 2007, I received a first Office Action (Exhibit I) for the '389 application. The Action, which was mailed on November 23, 2007, contains a section entitled "Priority," in which the Examiner notes that the '389 application "appears to claim subject matter disclosed in prior Application No. 09/927,850, filed 8/10/2001," but requires that "[a] reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c)" (Exhibit I). The Examiner did not, however, indicate in the Action that the '850 application went abandoned on March 7, 2005, and therefore, that such a priority claim would be improper (Exhibit I).

10. On December 23, 2008, I filed a response (Exhibit J) to the Office Action mailed November 23, 2007 in the '389 application. Pursuant to the Examiner's request in the Action, I also filed a Petition for an Unintentionally Delayed Domestic Priority Claim (Exhibit K), and amended the specification of the '389 application to insert a reference to the '850 application (as well as to the '860 application and U.S. Provisional Application No. 60/169,720) as the first sentence of the specification.

11. I was unaware of the two Filing Receipts (Exhibits F and H) until I reviewed the paper file for the '389 application, which was after I submitted the Petition for Unintentionally Delayed Domestic Priority Claim (Exhibit K), as neither Filing Receipt was (or is) in the electronic Image File Wrapper for the '389 application on Private PAIR.

12. In the response to the Office Action mailed November 23, 2007, I suggested that an interference be declared between the '389 application and U.S. Patent No. 6,433,145, which issued

from U.S. Application No. 09/487,792, which was filed on January 20, 2000 (Exhibit J).

13. Only when I received and reviewed the Decision on the Petition for an Unintentionally Delayed Domestic Priority Claim (Exhibit L) in March 2009 did I discover that the '850 application had become abandoned on March 7, 2005. The Decision (Exhibit L) states at page 2 that:

There does not appear to be copendency between the present application and application no. 09/927,850. A final Office Action was mailed July 6, 2004. In response a Notice of Appeal was filed January 6, 2005 with a three month extension of time, to which an Appeal Brief was due by March 6, 2005 or with a five month extension of time, could have been filed August 6, 2005. A request for an extension of time was not made in the 09/927,850 application. Thus, the '850 application became abandoned as of midnight August 6, 2005 and was not active when the present application was filed August 8, 2005. It is suggested that petitioners file a petition for revival in the '850 application for the purposes establishing copendency with the present application.

Thus, upon receipt of the Decision in March 2009, I first learned that the '850 application had become abandoned on March 7, 2005. I subsequently informed Dr. Noonan and Assignee for the '389 application of the Decision.

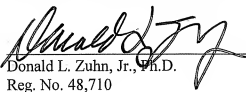
14. After learning that the '850 application had become abandoned on March 7, 2005, I conducted an investigation into the circumstances of the abandonment, and then filed a Petition to Revive an Unintentionally-Abandoned Application, seeking to revive the '850 application for the purpose of establishing copendency with the '389 application.

15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

Dated: August 17, 2009

By:


Donald L. Zuhn, Jr., Ph.D.
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